

**REMARKS**

Claims 63-124 are now pending and stand rejected. Specifically, claims 63-68, 70-73, 76-87, 89-93, 96-103, and 110-124 are rejected under 35 U.S.C. § 102(e) and claims 69, 74, 75, 88, 94, and 109 are rejected under 35 U.S.C. § 103. By this amendment, claims 63, 82, 83, 85, 86, 102, 116, and 122, are amended and claims 73, 74, 84, 87, 88, and 103 are canceled, without prejudice. In view of the above amendments to the claims and the arguments below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

***35 U.S.C. § 102 Rejections***

In paragraph 2 of the Office Action, claims 63-68, 70-73, 76-87, 89-93, 96-103, and 110-124 were rejected under 35 U.S.C. § 102(e) as being anticipated by Vega (U.S. 2002/012554 A1).

Applicant respectfully submits that Vega fails to anticipate the rejected claims for at least the reasons that are indicated below.

At the outset, Applicant respectfully submits that the criteria for a rejection under 35 U.S.C. § 102 as anticipated by a prior printed publication is firmly established. Specifically, each and every component of a claim in question must be met by the applied printed publication. For a claim to be anticipated by a single reference under 35 U.S.C. Section 102, that reference must on its own satisfy each and every recitation in that claim. *Upsher-Smith Laboratories, Inc. v. Pamlab, L.L.C.*, 412 F.3d 1319, 1323-24 (Fed. Cir. 2005); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368-69 (Fed. Cir. 2003); *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); *Rosco, Inc. v. Mirror Lite Co.*, 120 Fed. Appx. 832, 836 (Fed. Cir. 2005); *Animatics Corp. v. Quicksilver Controls, Inc.*, 102 Fed. Appx. 659, 670-71 (Fed. Cir. 2004).

Independent claims 63, 102, 116, and 122 are amended to recite limitations that are clearly not met by Vega. These claims are variously amended to recite limitations such as the area of interest is created and expressed by the user, rather than organized and presented in catalogs for the user to select from. Moreover, the claims are variously amended to recite either a caller paid line as one of the modes of communication or a dating service, each of which the

Examiner has acknowledged are not met by Vega. Therefore, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 102(e).

### **35 U.S.C. § 103 Rejections**

In paragraph 4 of the office action, the Examiner has variously rejected the claims 69 and 88 under 35 U.S.C. §103(a) as being unpatentable over a primary reference, Vega (U.S. Patent Application Publication No. U.S. 2002/012554 A1), in view of Walker et al. (U.S. Patent No. 5,884,272). Claims 74 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vega in view of Klingman (US 5,729,594). Claims 75 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vega in view of Foster et al. (US 4,897,867, hereinafter "Foster").

Applicant respectfully traverses that it would have been obvious to combine the references as the Examiner suggests and urges the Examiner to reconsider the rejections in view of the following reasoning set forth below.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. \_\_\_\_2007)) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various noted factors only "can" or "might" be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

"[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his

or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the

claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

Considering the governing criteria of obviousness, Applicant respectfully notes that the Examiner alleges that Vega discloses all of the limitations of the rejected claims and cites the following sections in Vega to support the rejections.

paragraph 47:

*[0047] Relevant information concerning the marketplace may be displayed on electronic units, e.g., a personal computer, cellular phone, PDA, television, etc. A variety of communication modes may be utilized to communicate with the marketplace/site, e.g., electronic transmissions, electronic mail, facsimile transmissions, telephone, postal submissions, and/or common carrier submissions. Electronic transmissions are typically encrypted, and access to certain aspects of the marketplace submissions are secured from access by unauthorized third parties.*

paragraph 62

*[0062] In a preferred embodiment of the disclosed method/system, a retaining engine computer system provides an electronic version of a catalog that advantageously lists the services, or packages of services, that are available. Available services/packages of services are typically broken into categories, e.g., medical, legal, financial, etc. A user, who is a potential client or purchaser, may access the retaining engine computer system through*

*conventional Internet technology, e.g., using a browser on his/her personal computer, PDA, cellular phone, or the like, to browse through the catalog of services. On-demand audio and/or video files may supplement conventional HTML Web pages within the catalog to effectively communicate and/or illustrate the available services. The user/potential customer may select various services, or packages of services, from among the services listed in the catalog that are to be retained, i.e., services to be purchased by the user.*

paragraph 77

*[0077] "About Us" link 108a guides a user 102 to a Web page providing typical information concerning a Web site owner, e.g., nature of business, management personnel, mailing/e-mail address, etc. "Log In" link 108b guides a user 102 and/or service provider (not pictured) to sign up/log in wizards 130, 150, respectively. Generally, sign up wizards 130, 150 collect relevant information concerning a user and a service provider, respectively, through data input screens 132, 152. For example, sign up wizards 130, 150 and data input screens 132, 152 may advantageously solicit user name, company name, mailing address, e-mail address, log in name and password, and/or credit card information (particularly in the case of sign up wizard 130/input screen 132 for prospective buyers). Additional information may also be solicited to facilitate data mining purposes, e.g., demographic information such as salary bracket, profession, age, family size and status, etc. Similarly, additional information may be solicited from service providers (and users that are not visiting in their individual capacities), e.g., nature of business, annual revenues, number of employees, service categories, etc. Thus, sign up wizards 130, 150 and data input screens 132, 152 collect information/data that is stored in buyer database 134 and service provider database 154, respectively.*

paragraph 88

*[0088] Beyond registration-related information, a registered buyer 102 may provide a description of services that the buyer is prepared to purchase by entering relevant information to input screen 132. Such information is advantageously stored within buyer database 134 for processing by retaining engine 200, and for potential review and consideration by registered service providers. According to system 100 of the present disclosure, entry of a service requirement by buyer 102 constitutes a CRO that is binding upon buyer 102 if accepted by a service provider. Thus, buyer 102 is required to input all information necessary to define the scope and pricing of the requested service when entering the record into buyer database 134 via data input screen 132. To the extent nonmaterial information is omitted from the service request created by buyer 102, retaining engine system 104 undertakes to fill such omissions to ensure a binding contractual relationship will be created upon acceptance by a service provider. Retaining engine 200 advantageously matches buyer requests entered to buyer database 134 with corresponding*

*service provider records contained within service provider database 154. Data filter 202 and associated processor 204 screens service requests submitted by buyers 102 to ascertain material terms that must be met by a service provider, e.g., nature of the services requested, timeframe required, maximum cost, geographic location, etc. Based on identification of material terms, data filter 202 and processor 204 apply processing scripts 206 to identify one or more buyer/service provider matches. For example, a buyer 102 who has forwarded a request for tax preparation services in the northeastern United States within the next two weeks at a cost not to exceed \$500 may be matched with the tax preparation specialist noted above, provided the tax specialist has availability within the next two weeks and can provide the necessary services in the requested timeframe.*

paragraphs 82-86

*[0082] Beyond registration and demographic information that is input to buyer and service provider databases 134, 154, respectively, additional information is entered into buyer and service provider databases 134, 154 via data input screens 132, 152 according to retaining engine system 104. Focusing first on information entered to service provider database 154 through data input screen 152, services that are available for purchase by prospective buyers is entered to service provider database 154 from time to time. Such services may include a wide range of services, spanning many different and diverse categories. For example, service providers may enter services into service provider database 154 that fall into service fields ranging from legal, medical, nursing, accounting, financial, architectural, counseling, educational, dental and health fitness services, to more hands-on services such as car repair, gardening, painting, plumbing, construction, and any other service that might be of interest to potential buyers.*

*[0083] Registered service providers that are logged in via log in wizard 150 are generally free to populate service provider database 154 with relevant details concerning the services available for purchase, including such information as description of services, geographic location/geographic coverage area, years of experience, references, pricing ranges, times of availability, and the like. Such information is stored in records within service provider database 154, with each record being associated with a specific service provider. In addition, promotional, marketing and advertising information and/or links to reference materials concerning a service provider's capabilities are entered via alternative data input screens 152 and are stored in seller community database 180.*

*[0084] Individual service providers are advantageously categorized within seller community database 180 according to relevant categories. In a preferred embodiment of the retaining engine system 104 of the present disclosure,*

*service providers are categorized according to geographic location/geographic coverage, and/or nature of services provided. Thus, individual listings 182 setting forth service providers and associated information concerning the services of such service providers may be viewed by potential buyers 102 and other validated visitors to retaining engine system 104. Listings 182 may be advantageously accessed as individual Web pages based on category-based links from one or more Web pages associated with retaining engine system 104.*

*[0085] For example, a service provider that specializes in income tax preparation and advice may register with retaining engine system 104 by providing relevant information in response to sign up/log in wizard 150, by entering such information into input screen 152. Such information is stored in service provider database 154. Beyond registering with retaining engine system 104, the tax preparation specialist may also enter information concerning his/her areas of expertise, years of experience, geographic location and geographic scope of practice, standard billing rate, and the like. Such information concerning the tax specialist is also stored in database 154. However, beyond the data stored in database 154, the tax specialist is preferably automatically included in seller community database 180 based on his/her geographic location/geographic scope of practice, e.g., northeastern United States, and future visitors to retaining engine system 104 will find information concerning the tax specialist on listings 182 that concern service providers in the northeastern United States and/or service providers that offer tax preparation services and advice.*

*[0086] Of note, links 184 to ancillary service provider Web pages 186 may be included in the information provided by service providers to seller community database 180. Thus, a visitor to retaining engine system 104 may advantageously link directly from listings 182 to access additional background information concerning service provider(s) of interest. Web pages 186 may provide static information, e.g., HTML pages, video/audio files and/or combinations thereof. Through inclusion of links 184, service providers are able to leverage their participation with retaining engine system 104 to provide extensive background information, testimonials, service examples and the like, to prospective buyers.*

The claims are amended to variously recite limitations such as 1) the area of interest is created and expressed by the user, rather than organized and presented in catalogs for the user to select from 2) a caller paid line as one of the modes of communication or 3) a dating service. At the outset, Vega does not teach a system, where the user creates and expresses the area of interest. That limitation is emphasized in each of the independent claims 63, 82, 102, 116, and

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122. In addition, claim 63 is amended to recite a communication environment accommodating a mobile communication lines and a dial-up telephone line that is a caller paid line. Claim 82 additionally recites that the communications relate to a dating service. Claim 102 additionally recites that the video data provided includes dynamic or still video with text data. Claims 116 and 122 additionally recite video recordings and text data. Applicant respectfully submits that the claims as they presently stand are not met by Vega alone or in combination with the secondary references Klingman, Walker, and Foster. The Examiner is respectfully requested to reconsider the claims as they presently stand and to the withdraw the rejections.

Respectfully submitted,

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